REMARKS

Claims relating to the non-elected group have been canceled without prejudice to applicant's right to file an appropriate continuing application directed thereto. Some of original claims 10-21 have been reworded so as to fall within the elected group.

The present invention is based, in part, on conducting a process in which the ß-glucanase activity is controlled such that a high content of soluble ß-glucan is realized. That activity may arise from enzymes added as such or in the form of a cereal employed in the process, as described at page 6, line 27 to page 7, line3. The claims have been revised to make this more clear. Claim 1 has also been reworded to more clearly indicate that the high content of soluble ß-glucan is more than 0.2% by weight in accordance with page 8, line 22 and to indicate that essentially lacking ß-glucanase activity means that the yield of soluble ß-glucan does not decrease by more than 20% in respect to the yield obtainable from a corresponding non-germinated cereal or mixture of cereals. An alternative independent claim has also been submitted based on claim 1 with the additional recitation that the enzymes present are such that more than 50% of soluble ß-glucan contained in the cereal is preserved in the final product as described, for example, on page 6 of the application.

The rejection of claims 5 and 6 under 35 U.S.C. § 112, first paragraph, on the grounds of enablement is respectfully traversed. The rejection is based on the assertion that the specification does not describe how to heat treat a material to eliminate certain enzyme activity and there is but one commercial product described in the specification which has those characteristics. It is respectfully submitted that these observations do not meet the Examiner's burden of establishing the factual basis for the asserted lack of enablement. Thus, basis for this rejection requires the Examiner to establish that those of ordinary skill in the art would not know how to heat treat a material to eliminate enzyme activity and a lack of description in the present specification does not suggest any such lack of knowledge. Destruction of enzyme activity by heating is a general phenomenon, well known throughout the art. The particular commercial product

in the working example is advantageous because it has a high content of soluble ß-glucan but there is no reason that any of the other commercial materials noted in the specification, or available in the art, could not be used in the present invention. Those skilled in the art would clearly be able to practice the claimed invention even if the particular commercial product noted in the application was discontinued.

The rejection of the claims under 35 U.S.C. § 112, second paragraph can be withdrawn in light of the foregoing amendment to further define the high content of soluble ß-glucan and the lack of ß-glucanase activity. The Examiner's statement that it is unclear what the basis of the range is is not understood since the range is stated to be "by weight". The Examiner's observation that the specification appears to be based on "by volume" would appear to be a suggestion that the percentage should be specified as w/v and this change will be made if the Examiner so desires. It should be noted, however, in the aqueous systems of the brewery industry, w/v values are not significantly different from w/w values. The Examiner's observation that it is unclear what units of weight or volume are being used is not understood since it does not matter which units are being used as long as those units are consistent. For example, 1of 100 pounds and 2.2 of 2200 grams are both 1 weight percent.

Claims 1, 2, 4 and 7-9 were rejected under 35 U.S.C. § 102 over Breworld. This rejection is respectfully traversed.

The Examiner has pointed to D.B.'s Oatmeal Stout which contains oatmeal and barley and then stated that these grains essentially lack glucanase activity. The basis for the Examiner's conclusion that these grains lack such enzyme activity is not set forth. It is respectfully submitted that this rejection is untenable in the absence of such a basis.

Regardless of the lack of a factual basis, it is respectfully pointed out that Breworld is entirely different from that of the present invention. All of the Breworld recipes use malt which provides the range of enzymatic activities. Among other enzymatic activities, malt supplies ß-glucanase which degrades ß-glucan. All enzymes except ß-amylase are formed during malting. The products prepared according to the Breworld worts will therefore neither have a "high content of soluble ß-glucan" nor a

content of ß-glucanase such that "more than 50% of the soluble ß-glucan contained in the cereal is preserved in the final product".

A rejection based on Section 103 is also not appropriate since there is nothing in Breworld which teaches or suggests a process for the production of a cereal wort or beer in which ß-glucanase activity is controlled to any extent or for any purpose.

The rejection of claim 3 under 35 U.S.C. § 103 over Breworld is also respectfully traversed. Even if "it is notoriously well known to use a malt extract (a condensed boiled malt wort) in the production of beer", the basic deficiencies in Breworld would not be eliminated. Further, if it was as notoriously well known and obvious, then surely the Examiner would have been able to find a reference so stating, rather than attempting to take administrative notice of an asserted fact.

The *Levin* case cited by the Examiner does not appear to be in point with the fact situation of the instant case. The present invention is not just a "formula for cooking food" to which further ingredients can be added or from which ingredients can be withdrawn according to taste. Rather the invention is based on a deep scientific insight into the enzymatic processes which are involved in brewing.

In light of all of the foregoing, it is respectfully submitted that this application is now in condition to be allowed, and the early issuance of a Notice of Allowance is respectfully solicited.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on January 20, 2000:

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Respectfully submitted,

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